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09/921,856	08/02/2001	Gregory P. Fitzpatrick	BOC9-2000-0082(217)	7129

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10/25/2005

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT

PAPER NUMBER

2165

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,856

Applicant(s)

FITZPATRICK ET AL.

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 4, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, and 11-17 are rejected under 35 U.S.C. 102(e) as being anticipated by de l'Etraz et al. (U.S. Patent No. 6,073,138).

As to claims 1, and 12, de l'Etraz et al. discloses a computerized method for generating a list of contacts, a machine readable storage having stored thereon a computer program for generating a list of contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps comprising the steps of:

first retrieving a plurality of contacts from an exposed, remotely accessible contact list, the exposed, remotely accessible contact list defining a first set associated with a user (See column 28, lines 6-30);

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list, said locally accessible contact list defining a second set distinct from said first set and associated with a different user (See column 15, lines 11-20);

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first identifying common contacts among said first compared contacts (See column 15, lines 11-24);

second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts (See column 15, lines 21-30, also see column 16, lines 58-67, also see column ;

second comparing said second retrieved contacts to said locally stored contacts (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13);

second identifying common contacts among said second compared contacts (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13); and

generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts (See column 3, lines 23-39, also see column 18, lines 9-12, and see column 18, lines 33-62).

As to claims 2, and 13, de l'Etraz et al. discloses further comprising the step of repeating said second retrieving, second comparing and second identifying steps for each first retrieved contact not identified as a common contact in said first identifying step (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13).

As to claims 3, and 14, de l'Etraz et al. discloses wherein said second retrieving step comprises the step of second retrieving a plurality of contacts from an exposed,

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remotely accessible contact list associated with one of said first retrieved contacts not identified as a common contact in said first identifying step (See column 3, lines 23-39).

As to claims 4, and 15, de l'Etraz et al. discloses a method generating a list of common contacts, a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps, said steps comprising:

exchanging at least two contact lists over a physical communications link (See column 7, lines 5-19), wherein each contact list defines a distinct set different from the other and corresponds to a different user (See column 18, lines 9-12, and see column 18, lines 33-62);

comparing contacts in said exchanged contact lists to identify matching contacts (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13); and

generating and storing a contact list defining yet another distinct set and containing said matched contacts (See column 3, lines 23-39).

As to claims 5, and 16, de l'Etraz et al. discloses wherein said exchanging step comprises the steps of:

establishing a wireless communications link; and, exchanging said contact lists over said established wireless communications link (See Figure 29, 2928, also see column 6, lines 55-65, wherein "wireless" reads on "laptop, palmtop, pda").

As to claims 6, and 17, de l'Etraz et al. discloses a method of generating a list of common contacts, a machine readable storage having stored thereon a computer program for generating a list of common contacts, said machine readable storage having a plurality of code sections executable by a machine for causing the machine to perform a series of steps, said steps comprising:

accessing a contact list defining a distinct set being stored in a remotely accessible database of contacts (See column 28, lines 6-30);

comparing contacts in said contact list with contacts in a stored database of contacts defining another distinct set, said contact list and said contacts in a stored database of contacts each corresponding to a different user (See column 28, lines 6-30);  
and

producing matching contacts as a result of said comparing (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13); and

providing a visual hyperlink for each matching contact produced by said comparing step (See Figure 27, shows "GUI" displaying results, also see column 18, lines 1-13, and see column 19, lines 36-43, wherein "visual hyperlink" reads on "a link to the public").

As to claim 7, de l'Etraz et al. discloses a common contact identification system comprising:

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at least two contact lists, each said contact list defining a distinct set comprising a plurality of contacts, each said contact list having a publicly accessible interface through which said contacts can be accessed remotely (See column 28, lines 6-30);

a comparator for comparing contacts in each of said at least two contact lists, said comparator identifying matching contacts in each of said at least two contact lists (See column 8, lines 26-61, also see column 28, lines 49-55);

a common contact list resulting from the comparison and defining yet another distinct set comprising contacts matched by said comparator (See column 8, lines 26-61, and see column 15, lines 21-52, also see column 18, lines 9-13).

As to claim 8, de l'Etraz et al. discloses wherein each said contact list is stored in a storage medium selected from the group consisting of a database, a contact management program data store, an e-mail program address book (See column 15, lines 14-40);

an instant messenger address book, a cellular phone address book, and a personal digital assistant address book (See column 2, lines 45-48, prior art, also see column 1, lines 25-30, prior art).

As to claim 9, de l'Etraz et al. discloses further comprising a communications link between said contact lists over which said contacts in said contact lists can be transmitted (See Figure 27, 2714, "Local Contact Pathway", also see column 15, lines 5-40, also see Figure 29, 2928).

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As to claim 11, de l'Etraz et al. discloses wherein said common contact list comprises at least one hyperlinked address of a matched contact (See column 3, lines 23-39, also see column 15, lines 5-40, and see column 19, lines 36-43, wherein "visual hyperlink" reads on "a link to the public").

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (U.S. Patent No. 6,073,138) in view of Rudman et al. (U.S. Pub. No. 2002/0042772 A1).

As to claim 10, de l'Etraz et al. does not teach wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link.

Rudman et al. teaches wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link (See Rudman et al. page 3, paragraph 0023).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified de l'Etraz et al. by the teaching of Rudman et al. to



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include wherein said communications link is selected from the group consisting of an infrared communications link, a short range radio frequency communications link, and a TCP/IP wireline link because it is well known in the art that communication channel can be constructed from a variety of both wireline and wireless technology.

### *Response to Arguments*

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Guha (U.S. Patent No. 6,108,651) teaches creating common attributes across heterogeneous databases.

Hall (U.S. Patent No. 6,643,686 B1) teaches counteracting message filtering.

Goddard (U.S. Patent No. 6,876,983 B1) teaches facilitating aggregate shopping.

Dept. of Computer Science, School of Engineering, UVA. How the Oracle of Bacon Works. 1996. (retrieved 9/21/2005).

Wikipedia Org. and Web Archive.org. SixDegrees.com. 1997-2001..(retrieved 9/21/2005).


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil  
October 20, 2005

  
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